Remarks

The applicant ahs amended the claims and present the following remarks and discussion regarding the patentability of the claims. The applicant submits that the above-provided amendments, along with these remarks, fully address each and every issue raised by the Office in the current Office Action and that the claim are in condition for allowance.

Claim Rejection – 35 USC § 103

The Office has repeatedly rejected the claims of this application using the same references as provided in the current Office Action. The applicant met with the examiner for this case to review the cited references and the invention prior to filing of the RCE. It was the applicant's understanding that the Office understood the distinction between the claimed invention and the cited references and that the claims, as presented in the RCE would be allowable. However, the applicant is a bit surprised by the Office's present position with regards to the claims. In an effort to be complete and final, the applicant is presenting this somewhat lengthy response to fully set forth what is described in the cited references and how the present invention is different. In other words, the applicant is going to point out what elements of the current claims are not described, suggested, or taught by the cited references and, how the cited references actually teach away from the present invention. Further, application of the cited references to the claims actually results in destroying the purpose of the cited references.

The Office has rejected claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Joshi (United States Patent Number 6,843,723) in view of Brosnan et al. (United States Patent Number 6,682,432). The applicant presents the following information:

(a) overview of t Joshi

(c) overview of Brosnan

(b) description of the distinguishing elements of the present invention

Overview of Joshi

It is very clear from the Joshi reference, that the only described embodiment is a video gaming machine with a dedicated theme – Who Dunnit? In column 4, lines 7-15 the patent does state that the described invention could be implemented in other games. However, it is very important to note that Joshi states the invention can be implemented with other games and/or with alternative game themes. For the sake of simplicity, this Who Dunnit? game or the "other

games" or "alternative game themes" will collectively be referred to as the underlying game. Thus, the machine in which the Joshi invention is embodied provides a dedicated underlying game with a theme, well defined rules, and a payout table. One embodiment is the "Who Dunit?" theme. The game is described as generally operating like a slot machine. This is an important point in understanding the Joshi reference because Joshi only describes two main elements that exist in all described embodiments: (a) the modification of the underlying game and bonus game (i.e. changing to motif) and (b) the provision of a bonus game consistent with the theme of the underlying game and presented in lieu of the underlying game.

Changing the Motif of the Underlying Game and Bonus Game

Beginning in column 9 and line 15 of the detailed description (as well as in the summary section) the Joshi patent describes changing the motif of the underlying game, which is also carried into the bonus game. The changing of the motif is based on calendared occasions, such as holidays (Christmas, Halloween), societal events, or the like. The patent described modifying the elements of the slot machine line reels to include elements commensurate with the theme. Thus, during defined periods of time, the theme of the game can be modified in accordance with a special event.

Provision of a Bonus Game

The Joshi patent describes providing a bonus game as an incentive to encourage further play of a video gaming machine. The bonus game is described beginning in column 4 of the detailed description. The bonus game is described as being invoked as a result of certain basic game outcomes of the underlying game (col. 4 line 30). This aspect is further described in column 5 starting at line 35. It is clear that the Joshi reference describes invoking a bonus game that is different from the underlying game, although it may share the same theme. The bonus game is *triggered* by the outcome of the underlying game. It is important to note that once triggered, Joshi describes the bonus game as being completely independent and in lieu of the underlying game. Thus, although the underlying game outcome may trigger the bonus game to start, the outcomes of the underlying game have not effect whatsoever in the outcome of the bonus game. In addition, the elements in the reel of the underlying game are described as including certain elements that are only relevant to the bonus game. These elements do not appear in the payout table of the underlying game and are not part of the underlying game.

Rather, these elements are used to trigger entrance into the bonus game. (See column 5 lines 35-62).

It is important to point out that the Joshi reference only describes a bonus game that is played completely independent of the underlying game. Other than being on the same machine and sharing a similar theme, the games are completely unrelated. The bonus game has its own rules, its own characteristics and its own display screen. (See column 5 line 57 to column 9 line 15) Further, the underlying game is completely non-existent while the bonus game is being played. The CPU is completely dedicated to presenting the bonus game (col. 5 lines 63-65 and figures 5, 6, 7, 8, 9, 13, 14, 15 and 16) and the machine interface is defined to control the operation of the bonus game (col. 6 lines 58-60). When the bonus game is active, the user cannot play the underlying game. When the underlying game is active, the user cannot play the bonus game. Joshi describes an event that triggers entrance to the bonus game. This event is either the occurrence of special symbols or even a special outcome of the underlying game.

Overview of Brosnan

Brosnan describes an open architecture for communications within a gaming network. More specifically, Brosnan teaches providing protocol translations so that a variety of types of machines or systems can communicate over a common network and the Brosnan invention enables such communication. (See column 7 lines 43 to 55). Thus, in a casino environment, Brosnan would be directed towards a device that sits on the casino network and communicates with the gaming machines, the accounting machine, the player tracking servers, etc. The invention described only operates on data that is available on that network and translating protocols that are transmitted over that network. Brosnan does not describe, suggest or teach interfacing to the controller of a video gaming machine to obtain data that is not otherwise available on the network.

Distinguishing the Present Invention

The present invention is not described, suggested or taught in Joshi. Further, by combining Joshi with Bronson, the present invention is not rendered obvious.

Claim 1: Claim 1 has been further amended in this response, not to include any further limitations from what has already been presented, but rather, to more particularly articulate the inventive and distinguishing aspects of the present invention. The elements of claim 1 are described element by element as follows:

Preamble:

The preamble of the claim describes that the present invention operates in the environment of a gaming machine that presents a video game that is complete with a defined payout table. This could include a video poker game, a video slot machine or any of a variety of video games. Further, the preamble states that a promotional event is provided and the winning criteria for the promotional event is defined independently from the payout table but, is dependent upon the outcomes of the video gaming machine. This is supported in the figures and the description of the application showing that the promotional events for a video poker game are actual hands that are potential outcomes of the video poker game.

The controller box elements:

(Element 1) Claim 1 recites a controller box that interfaces to the main processor of the video gaming machine. The Office alleges that figures 2 and 17 of Joshi show this element. The applicant disagrees. Figure 2 of Joshi shows the controlling mechanism for the actual machine embodying the described invention. The CPU 16 is the video game processor. This is not the same as the claimed controller box. Further, it is clear from Joshi that the control system described in figure 2, which is an integral part of the video gaming machine, operates to not only present the underlying game but also the bonus game (see column 4 lines 16-35). As will be described below in more detail, the controller box of claim 1 is not the same as the video game processor and further, it only provides control of the promotional event, not the underlying game. The controller system of figure 2 is the main processor of the video gaming machine and as such cannot be the controller box recited in claim 1. Thus, the control system in figure 2 does not describe, suggest or teach the controller box of claim 1.

Figure 17 of Joshi shows an external controller system 152 that is some how connected to the gaming machine but there is no indication whatsoever as to how this controller system interfaces to the gaming machine. The external controller box illustrated in figure 17 is described as monitoring wager activity and play activity for the various machines and then using this information to determine or control which themes or motifs are to be displayed on the

machines. Further, the controller box in figure 17 only provides control over the motifs displayed by the machine. This control could be provided in a variety of ways and most typically, would be by interfacing to the machine over the network connection available on such typical machines. This does not in any way imply that the external controller of figure 17 is connected to the processor of the video game. In fact, there is no motivation to assume that this would be the case because there is no need for such an external device that simply monitors wagering activity and provides motif control to actually interface to the processor.

The Office also alleges that the text in column 2, lines 40-42 describes a controller box interfacing to the processor of the video game. This text simply states that a plurality of visual element data sets are stored in a memory device accessed by the processor. This certainly does not disclose a controller box that interfaces to the processor. There is no indication whatsoever regarding what puts the visual element data sets into the memory. This could be done during the manufacturing process of the game by burning the images into ROM, loading the images into non-volatile memory, loading the images from another media etc. But Joshi does not describe, suggest or teach how this is loaded into memory. Further, even if it is assumed that the controller of figure 17 operates to load these elements into memory – which can only be concluded by using a very large imagination – it still does not disclose a controller that interfaces to the processor. This would be a controller that interfaces to a shared memory, which is clearly not the same as interfacing to a processor.

It should be noted that the Office states that "the combination of the memory device and processor is a controller box that is operable to interface to the video gaming machine". As pointed out, this memory device and processor, which are illustrated in figure 2, are certainly NOT a controller that is operable to interface to the video gaming machine. Rather, it is indeed the video gaming machine itself. As such, the argument is flawed because claim 1 recites a controller box that interfaces to the processor. Thus, the controller box is separate and distinct from the processor. To apply the Office's argument would require stating that the controller box interfaces to itself.

(Element 2) The controller box as recited in claim 1 operates to (a) display promotional content on the display of the video gaming machine (b) in a manner that allows the video game to continue to be presented and operational on the video gaming machine. Joshi teaches a processor (see figure 2) that operates to control the video display to present the underlying game

or the bonus game. Joshi does not describe a controller that operates to display promotional content on the display of the video gaming machine. The controller as recited in claim 1 is (a) different from the processor of the video game, (b) interfaces to the processor and (c) is able to control the display of the video gaming machine. This is not described, suggested or taught in Joshi and in fact, trying to stretch Joshi to include this element would destroy Joshi – which describes a video game machine that includes a single processor that first runs an underlying game and then transitions to a bonus game.

Further, the controller box as recited in claim 1 does not interfere with the underlying game. The underlying game is still active and presented on the display while the controller box of claim 1 displays the promotional event. This is not the same as changing the motif of the underlying game. The underlying game in claim 1 is completely untouched, no motif change, no element changes. The controller provides a promotional event that is displayed independent of the underlying game. Joshi, on the other hand either modifies the underlying game by changing the motif or, overrides the underlying game by presenting a bonus game. Neither of these embodiments encompasses the present invention.

(Element 3) The controller box in claim 1 monitors the activity of the video gaming machine to determine if a naturally occurring outcome of the underlying video game meets the winning criteria defined for the promotional event. This is not described suggested or taught in Joshi. The Office again equates the controller box to the processor in addressing this element stating that the "controller box, which includes the CPU (16), monitors the activity of the video gaming machine to determine if the winning criteria have been met. The controller box provides information indicating that the winning criteria for a particular promotion event have been satisfied – by causing payout mechanism (22) to pay out winnings." Again, this argument is flawed because the Office is confusing the video gaming machine with the controller box of claim 1.

The controller box recited in claim 1 is not the same as the processor of the video game. The invention recited in claim 1 does not alter the underlying game which is being presented by the processor of the video game. Rather, it monitors this activity to determine if the winning criteria of the promotional event have been met. More importantly, the processor in Joshi monitors the outcome of the underlying game to determine if a winning event occurs for the underlying game or, if a transitioning event occurs that will result in the invocation of the bonus

game. Then, the processor monitors the outcome of the bonus game to determine if a winning event occurs. There is no description whatsoever of monitoring the activity of the processor pertaining to the underlying game to determine if winning criteria for a bonus game or promotional event that is presented at the same time as the underlying game has been satisfied.

Further, claim 1 has been amended to indicate that the winning criteria for the promotional event are a naturally occurring outcome of the video game. This is not described, suggested or taught in Joshi. Rather, Joshi only teaches invoking a bonus game based on the naturally or augmented occurring outcomes of the video game and then, providing awards based only on the outcome of the bonus game which is totally independent from the underlying game.

(Element 4) Claim 1 recites that the controller box provides information indicating that the winning criteria for a particular promotional event have been satisfied. This information is obviously provided to the promotional server so that awards can be provided or credited to the user. The controller box of claim 1 is a separate device from the processor of the video game and the promotional event server. When the winning criteria are satisfied, the controller then notifies the promotional server. Joshi does not describe, suggest or teach this element of claim 1. If one equates the controller 152 in Joshi to the promotional event server, there is no description of a controller box that interfaces to the processor of the video game and hence, no communication from the controller box to the promotional event server. One cannot equate the controller 152 to be equivalent to the controller box of claim 1 as clearly articulated above: (a) Joshi does not describe this as interfacing to the processor (it just shows it as interfacing to the video gaming machine) (b) Joshi does not describe this as displaying a promotional event on the display of the machine (it simply provides motif information rather than controlling the display) and (c) Joshi does not describe this as monitoring the occurring results of the video game processor (it only monitors the wagering information).

The promotional server elements:

Claim 1 recites a promotional server that is separate and distinct from the controller box. The promotional server is communicatively coupled to the controller box. As such, the promotional server delivers information pertinent to the promotional events to the controller box and not to the processor of the video gaming machine.

(Element 1) The promotional server maintains a database of promotional events with each promotional event being defined by promotional content, winning criteria and scheduling

information. This promotional server is not the same as the controller 152 described in Joshi. The controller in Joshi communicates directly with the video gaming machine and provides motif information to the video gaming machine. Further, the information available at the controller 152 in Joshi does not define a promotional event. Rather, it simply provides information about a motif. This is very different from a promotional event that includes a promotional content, winning criteria and scheduling information. At a minimum, Joshi does not describe, suggest or teach: (a) a database of promotional events as recited in claim 1 and as described and defined in the specification, (b) a promotional server that provides a promotional event to a controller box, (c) a promotional server that provides promotional events that include the winning criteria. Addressing this last point further, the bonus game in Joshi, as well as the underlying game are all defined and loaded into the video gaming machine. The controller 152 in Joshi is only described as watching wagering and play characteristics and motivating the change of the motif of a video gaming machine based on such information. Changing the motif of a game or a bonus game is not the same as a promotional server that maintains a database of promotional events, provides these promotional events to a controller box that independent of the video game processor, and the promotional events define the schedule and winning criteria information.

(Element 2) Claim 1 further recites that the promotional server delivers at least one promotional event in the database to the controller box. As stated above, Joshi does not describe a promotional server that communicates with a controller box as defined in claim 1 and in the specification, much less provide at least one promotional event.

(Element 3) Claim 1 also recites that the promotional server receives messages indicating that the winning criteria for the promotional event has been met. This is not described, suggested or taught in Joshi. In the broadest sense, Joshi describes a controller 152 that receives or downloads "information on the wager inputs". Monitoring information on wager inputs is not the same as receiving messages indicating that the winning criteria of a promotional event has been met. The Office actually concedes this point but then states that it is well known to send all information regarding winnings to a server for casino accounting purposes. Further, the Office alleges that Brosnan teaches reporting winning conditions to an accounting server. The Office then alleges that it would have been obvious to modify Joshi in view of Brosnan to

have the server receive messages from the controller box indicating that the winning criteria for a particular promotional event have been met.

First of all, as previously stated, Joshi does not describe, suggest or teach a controller box or a promotional server as recited in claim 1. Although the Office alleges that the CPU 16 in the video gaming machine is the controller box as recited in claim 1, it is very clear that this is not the case. The CPU 16 in Joshi is the video game, not a controller box that places content on the screen independent of the CPU 16. Secondly, the Office is correct, it is well known in the art for a video gaming machine to provide information regarding winnings to a server for casino accounting purposes. However, it is also well known in the art that video games that are networked in a casino environment only provide information regarding the winnings in accordance with the payout table. Losing hands are not reported to a server for casino accounting purposes for obvious reasons. That is one of the reasons why the present invention as recited in claim 1 is novel. The winning criteria for the promotional events can be defined independent of the payout table. Thus, the controller box needs to interface to the processor in the video gaming machine to determine the results of the various plays. For outcomes that are not in the pay table, this how the results information can be obtained. Brosnan teaches taking the normal information that is available from video gaming machines and converting it to a protocol that is common among other devices on the network. Brosnan does not describe, suggest or teach interfacing to the processor of the video game to identify each and every result, comparing the results to winning criteria defined independent from the payout table, making this comparison by a controller box that operates independent from the processor in the video gaming machine and passing this information to a promotional server.

One more additional point clearly distinguishes the invention as recited in claim 1 from Joshi and Joshi combined with Brosnan. The controller box recited in claim 1 operates independent from the processor in the video game, monitors the processor in the video game and interfaces to the processor in the video game. The promotional event is defined in a promotional server independent of the video game, is provided to the controller box, and is displayed on the display of the video game without disrupting the underlying game. Thus, the present invention operates as a parasitical device or system to the video game, not as an integral part of the video game. Joshi describes a bonus game and an underlying game that are all part of the video game, presented by the processor of the video game, and that cannot coexist on the video game.

Claim 2: The Office alleges that Joshi teaches the promotional server as further defined by this claim. The applicant disagrees. Joshi does not describe, suggest or teach the promotional server. Further, if one equates the controller box 152 described in Joshi to the promotional server, as the Office alleges, the controller box 152 falls significantly short of the elements described in this claim. The controller in Joshi only provides motif information to the video game. As such, the controller 152 does not:

(a) defining an award to be associated with the promotional event – rather this is predefined within the bonus game completely independent of the controller 152;

(b) defining the winning criteria for the promotional event – rather this is predefined within the bonus game completely independent of the controller 152;

(c) receiving instructions to store the defined promotional event – there is simply no correlation between this and anything described in Joshi (the present invention receives instructions from an operator that defines the promotional event and stores it into the database);

Claim 3: The office alleges that Joshi discloses an interface to create graphics and textual content to be included in the promotional content. The applicant disagrees. Claim 3 has been further amended to show that this aspect of the claimed invention allows an operator to change the promotional event for a video gaming machine that has been deployed in a gaming environment. The structure in Joshi does not describe the present invention and further, the video gaming machines in Joshi have the underlying game and bonus game loaded into them prior to deployment and there is no teaching in Joshi regarding the ability to change anything in the operation of the game, other than simple motif changes or predefined payout tables.

Claim 4: Similar to claim 3, claim 4 is not referring to an "ability" to create content, because as the Office points out, clearly Joshi inherently implies that content is created "somewhere". However, as recited in the claim, this software program allows an operator to interface to the system, define content, define graphics, define text, etc. that is included in promotional events that can be changed in a deployed system. Even if one stated that an independent program existing external to the Joshi system is used to create such content, there is no suggestion in Joshi as to how this modified content is incorporated into the video gaming machine.

Claim 5: Claim 5 depends from claim 1 and further recites that the controller box is associated with a single video gaming machine and that it is operative to display content without altering the content of the underlying game in the video gaming machine. The Office alleges that figure 18A describes such a controller box. As described above, Joshi does not disclose the claimed controller box nor does Joshi disclose providing of a promotional event that is presented coterminous with the underlying game and yet, does not alter the underlying game. First of all, if the Office alleges that the motif meets this obligation, the applicant disagrees strongly. Changing the motif may not change the overall operation of the underlying game but it does alter the underlying game. The present invention does not alter the content of the underlying game – period. Joshi describes a system that does alter the underlying game (changing the motif) or totally overrides the underlying game by presenting a bonus game. Thus, Joshi does not describe the elements of claim 5.

Claim 6: Claim 6 depends from claim 1 and further limits the claim by reciting the controller box receiving entertainment content from an entertainment source and displaying the entertainment content on the display of the video gaming machine. The Office alleges that the motif described in Joshi discloses this element of the invention. The applicant strongly disagrees. Entertainment content is clearly defined in the specification to be feeds from entertainment sources such as cable television, satellite feeds, recorded video feeds etc. Changing the motif on a video game is not entertainment content, at best it is simply decorations or augmentation of a different sort of entertainment content – a video game. However, the recited claim requires a controller box, which is not described in Joshi, that interfaces to an entertainment feed, which also is not described in Joshi, and the entertainment content received from the entertainment feed through the controller box, in compliance with the requirements of the parent claim 1, is presented on the display without altering the underlying game of the video machine. Thus, even if motif content could be construed as a form of entertainment, the very nature of this entertainment is to alter the underlying game. Thus, such application would destroy the Joshi reference.

Claim 7: Claim 7 depends from claim 1 and further limits the claim by stating the video gaming machine is a video poker machine and the winning criteria for the promotional event identifies a particular poker hand that is not included in the payout table of the video poker machine. The Office lumps the rejection of claims 7-10 into a single statement stating that Joshi teaches the

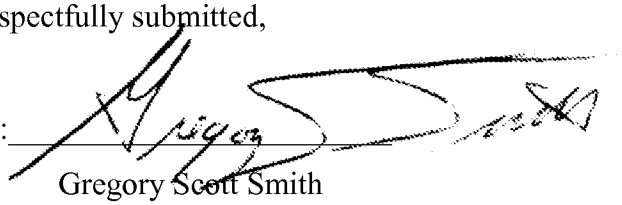
implementation on both video poker and video blackjack machines and further, that while the choice of which hands to make into winning criteria is a matter of design choice – any combination of cards could be considered a "winning hand" and Joshi teaches that the winning criteria may be the appearance of three symbol that are not included on the payout table. The Office thus concludes that Joshi teaches winning combinations that are not in the payout table and that are a particular hand. The applicant strongly disagrees with the Office's characterization of Joshi.

Joshi does not describe a promotional event that has any winning criteria that is associated with any operation whatsoever of the underlying game. All Joshi describes is invoking a bonus game based on a result of the underlying game. The winning criteria in the bonus game of Joshi are completely independent of the underlying game and in fact, the underlying game is non-existent when the bonus game is active. There is no relationship whatsoever between invoking a bonus game that overrides the operation of the video gaming machine based on a result of the underlying game and, identifying a result of the underlying game as winning criteria for the promotional event. These same arguments equally apply to claims 8, 9 and 10. Joshi simply does not describe the claimed invention and as such, it cannot possible describe this aspect of the claimed invention.

Conclusion

Applicant respectfully submits that the currently pending claims are in condition for allowance and respectfully requests the Office's consideration. If the Office has any questions or if there are any actions that can be handled through an Examiner's Amendment, the applicant requests the Office to contact the attorney of record using the below-provided contact information.

Respectfully submitted,

By: 

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